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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,178	03/16/2001	Toyohisa Oya	2870-0164P	5742

2292 7590 05/05/2003

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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,178

Applicant(s)

OYA ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2003 :
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17-22, 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Takeuchi or Nakamura et al (Nakamura.) in view of the combination of Cerquone et al (Cerquone) and EP 0762196 (EP'196). Note to Takeuchi in the abstract, the exemplified compound in columns 5-20 compound I-1 to I-28, column 63, lines 49-63; Nakamura in the abstract, exemplified compound in columns 7-33, compounds (1) to (90), and column 116, lines 57-67, column 117, lines 1-4. Takeuchi and Nakamura disclose both photosensitive silver halide material and heat-development light sensitive material. In the case of a heat-development light sensitive material the light-sensitive silver halide emulsion may be used together with an organosilver salt oxidizing agent. Cerquone discloses a photothermographic material which contains a combination of the use of the color developer for dye forming coupler and the reducing agent for silver ion. Note for instance the sulfoamidophenol and the reducing agent, which react with silver salt oxidizing agent to produce desired dye image (column 6, compound A to D and lines 50-60). EP'196 discloses a phenol compound as reducing agent for silver salt. Note for instance compound A on page 2 and compound on page 3.

3. Therefore, it would have been obvious to use the phenol compound as reducing

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agent for silver ion in combination with the color developer taught in either Takeuchi or Nakamura with an expectation of producing a desired dye image, and thereby provide the invention as claimed.

3. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi or Nakamura et al (Nakamura) as applied to claims 17-22, 25-27 above, and further in view of JP10339934 (JP'934). The phthalazine compound has been known in JP'934 as to provide a photothermographic material with low fog and to improve photothermographic property. See US patent no. 6,146,822 which is equivalent to the JP'934 in column 5, compound (I). It would have been to the worker of ordinary skill in the art to incorporate the phthalazine derivative taught in JP'934 for same reason, and thereby provide a material as claimed.

Response to Amendment

4. Applicant's arguments filed February 26, 2003 have been fully considered but they are not persuasive. It is the Examiner's position that the claimed invention is prima facie obvious over the applied prior art of record. The phenol compound has been known in used as reducing agent for silver ions and the hydrazine taught in Nakamura or Takeuchi has been known as color developing agent, and Cerquone et al discloses the use of reducing agent for silver ion in combination with color developing agent to produce a desired image, and the use a known reducing agent in the material containing color developing agent would have been found prima facie obvious to the worker of ordinary skill in the art.

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The argument with respect to the unexpected results are not persuasive. First, the results are irrelevant to the applied prior art of record, namely Nakamura and Takeuchi. The comparative samples shown in the Declaration were prepared in the same manner as the preparation of samples 101-120 of Example 1 of the specification. These samples are not color photosensitive material taught in Nakamura or Takeuchi. Therefore, it is improper to conclude that the material claimed in the present claimed invention has unexpected superior properties over that of the applied prior art of record.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
April 25, 2003


Thorl Chea
Primary Examiner
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